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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/369,690	08/06/1999	MASATO TAKEUCHI	49233-(1117)	7128
21874	7590	09/28/2004	EXAMINER	
EDWARDS & ANGELL, LLP P.O. BOX 55874 BOSTON, MA 02205			WON, MICHAEL YOUNG	
			ART UNIT	PAPER NUMBER
			2155	
DATE MAILED: 09/28/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/369,690	Applicant(s) TAKEUCHI ET AL.	
	Examiner Michael Y Won	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 2155

### **DETAILED ACTION**

1. Claims 1-7 have been re-examined and are pending with this action.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Tso (US Pat No.6085201 A).

As per claims 1-7, Tso teaches of an information processing device (see col.1, lines 4-7) and a storage medium carrying program readable by a computer (see col.3,

Art Unit: 2155

lines 21-28), which causes the computer to transmit and receive electronic mail over a transmission line, comprising of: a screen (see Fig.1, #2) for displaying received electronic mail to a user (see col.4, lines 5-12); a memory means (see Fig.2, #4 and col.3, line 46) for storing answer examples for a reply mail (see col.4, lines 23-24 and col.5, lines 7-9); a content selecting means for presenting a content of received mail and requiring a user to pick therefrom at least one or more portions of contents necessary for preparing a reply to the received mail (see Fig.3, #231, #233, & #235; col.4, lines 31-36; col.5, lines 49-53; and col.6, line 66 to col.7, line 13); an candidate answer message selecting means for requiring a user to select any of the answer examples stored by the memory means (see Fig.3 and col.5, lines 42-48 & 51-60); an answer example adding means for additionally storing the answer example prepared by the reply example preparing means into the memory means (see col.6, lines 59-63); and a reply-mail preparing means for preparing a reply mail by coupling at least one or more portions of contents selected by the contents selecting means with answer examples selected by the answer example selecting means (see Fig.3; Fig.4; and col.6, lines 66-67 to col.7, lines 1-13), wherein said reply e-mail includes said at least one or more portions of said received e-mail (see col.2, lines 59-67). Tso does not explicitly teach setting the sender of the received mail as an addressee of the reply mail and the receiver of the received mail as an addresser of the reply mail, although Tso does teach that one of the response actions can be responding to the writer (see col.4 lines 31-34). Nonetheless, it would be inherit that such a response would entail setting the sender of

Art Unit: 2155

the received mail as an addressee, to, or the like and the receiver of the received mail as the addresser, from, or the like, as is well known and currently applied in all email systems.

### ***Response to Remarks***

3. In response to the argument regarding "reply-mail preparing means for preparing a reply mail by coupling at least one or more portions of contents selected by the contents selecting means with answer examples selected by the answer example selecting means (see Fig.3; Fig.4; and col.6, lines 66-67 to col.7, lines 1-13), wherein said reply e-mail includes said at least one or more portions of said received e-mail (see col.2, lines 59-67)", Tso clearly teaches these limitations. Tso teaches of "**context-appropriate sentences** to include in the outgoing text message based on the actual content of the **input text passage**" (see col.2, lines 65-67), wherein the input text passage can be "portion of a received text message" (see col.2, lines 61-64).

Therefore, it is inherent by the teachings of Tso, for example, if an e-mail message was received such as "Can we meet at Joe's Diner at 12:00?", the teaches of Tso would suggest "Yes we can" or "No we cannot" "meet at Joes's Diner at 12:00.". The teachings of Tso do not teach away from the claimed invention and clearly do not suggest portions of a received e-mail cannot be included or inserted in the outgoing "context-appropriate sentences" message.

It is highly suggested that the claims be amended to clearly define the novel aspect of the invention such as including functional elements that teaches away from prior art or teaches an improved means than that of prior art

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

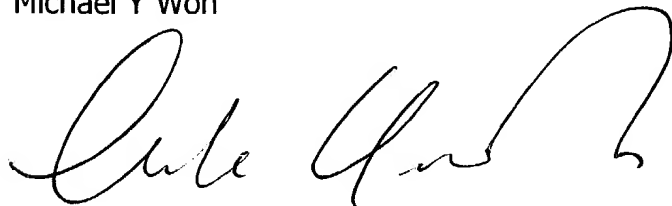
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y Won whose telephone number is (571) 272-3993. The examiner can normally be reached on M-Th: 6AM-3PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Y Won



September 23, 2004

  
HOSAIN ALAM  
SUPERVISORY PATENT EXAMINER